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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/584,045	05/30/2000	Andrew Hausman	3524/14	9896
29858	7590	10/01/2003	EXAMINER	
BROWN, RAYSMAN, MILLSTEIN, FELDER & STEINER LLP 900 THIRD AVENUE NEW YORK, NY 10022			SNAPP, SANDRA S	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 10/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/584,045

Applicant(s)

HAUSMAN, ANDREW

Examiner

Sandra Snapp

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-- The MAILING DATE of this communicati n appears on the cover sheet with the corresp nd nce address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-20 and 34-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-14,21-33 and 38-40 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 May 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6, 7, 11.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Priority

The Examiner acknowledges the present application claims priority to provisional application serial no. 60/152,017 filed 09/01/1999.

Information Disclosure Statement

The information disclosure statements (IDS) submitted on 11/07/00, 04/16/01 and 08/28/01 were filed in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements were considered by the examiner.

Drawings

The drawings are objected to because the margins do not comply with 37 C.F.R. 1.84. Also, Figs. 4, 9A and 10 contain black surface shading which is not permitted. Reference number "72" is shown in Fig. 2, yet there is no reference number "72" listed in the specification. Either the reference number should be deleted, or the specification should be amended to include the reference number. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

The abstract of the disclosure is objected to because it is too long. Correction is required. See MPEP § 608.01(b).

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Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Preliminary Amendment

The first instruction of the Preliminary Amendment states "At page 2, lines 14, please delete "Bloomberg PowerMatch sm" and replace it with - -BLOOMBERG POWERMATCH ^R (a registered service mark of Bloomberg L.P.)"- - however, when such statement is inserted into the specification, the resulting language is awkward and redundant. It is requested the Applicant review this one amendment for clarity.

Election/Restrictions

Restriction to one of the following inventions was required under 35 U.S.C. 121:

- I. Claims 1-5, 11-14, 24-28 and 31-33, drawn generally to a trading system with a computer system having programming that updates information defining the enablement relationships between counterparties in the trading system, classified in class 705, subclass 37.

- II. Claims 6-10, 21-23, 29-30 and 38-40, drawn to a trading system with a computer system having programming that displays trading orders and broadcasts notification messages, etc., classified in class 705, subclass 37.
- III. Claims 15-20 and 34-37, drawn to a trading system with a computer system having programming that , classified in class 705, subclass 37.

The inventions are distinct, each from the other because of the following reasons: Group I focuses more on the respective parties to the trading system, Group II is directed more to the physical display and arrangement of the trading system, and Group III identifies the actual trading system and the mechanics thereof. Although all three Groups fall within Class 705, the subject matter is very distinct and would require substantially different searches to be performed. As such, a restriction requirement is in order to more clearly define and limit the application to a single inventive concept.

During a telephone conversation with Mr. Frank DeRosa on July 15, 2003 a provisional election was made with traverse to prosecute the invention of Group III, claims 15-20 and 34-37. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-14, 21-33 and 38-40 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Objections

Claims 34 and 35 are objected to because in the last line of the preamble, the language “comprising step of” should be “comprising *the steps* of” since there are multiple steps.

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Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15-20 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 15-20 are rejected because it is unclear whether the claims are directed to a system having programming as a limitation, or to a system in combination with programming.

Claim 34 is indefinite because the phrase “user stations” in line 16 is confusing. It is unclear if these user stations are the same as previously identified in line 2 of the claim, or if they are new, different user stations. If the user stations of line 16 are the same as the previously identified user stations then the phrase should be preceded by “said” or “the.” Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 15-20 and 34-37 are rejected under 35 U.S.C. 101 because they claim a “system” wherein both apparatus claim language and method claim language are present. Therefore, it is unclear if the applicant is actually claiming a method or an apparatus. Clarification is required

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and can be made in the form of a statement on the record stating the Applicant's intentions (i.e. claim 15 is directed to a method, etc.)

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15-20 and 34-37 are rejected under 35 U.S.C. 102(b) as being anticipated by the Ausubel patent (US 5,905,975).

The Ausubel reference discloses a trading system having a plurality of user stations each including at least one display device, at least one user station for each party, and a central computer coupled in a communications network, the central computer processing trading orders between counterparty pairs of the parties for forwards for a plurality of forward terms (col. 6, lines 16-29), and

programming for enabling first counterparties to sequentially aggress a series of trading orders of second counterparties for a given forward term (col. 11, line 5 through col. 12, line 38) (claim 15);

programming for executing, within a predetermined time period, a new trading order having the same pricing and size terms as a trading order that was executed between a counterparty pair immediately before the predetermined time period (col. 29, lines 1-42) (claim 16) and the programming includes logic for accepting inputs approving execution of the new

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trading order from a selectable area of the display devices of each counterparty of the pair (col. 7, line 66 through col. 8, line 19) (claim 17);

programming for adding two or more new trading orders, each having at least one of varying price and size terms, to the trading system for forwards in a same forward term (col. 11, line 5 through col. 12, line 38) (claim 18);

programming for automatically adding a new trading order to the trading system, entered at a user station, having substantially same pricing and size terms as an existing trading order, wherein the new trading order includes information identifying a party at whose user station the addition of the new trading order was entered (col. 29, lines 1-42) (claim 20).

The Ausubel reference also discloses a trading system having a plurality of user stations each including at least one display device, at least one user station for each party, and a central computer coupled in a communications network, a method for processing trading orders between the parties for forwards in a plurality of forward terms, the method comprising the steps of: defining counterparty enablement relationships between counterparty pairs of the parties for trading forwards for the forward terms (col. 8, line 58 through col. 9, line 13), displaying trading orders of the first parties on the display device of the second parties (col. 11, lines 5-32) (claims 34-37), and

enabling the second parties to sequentially aggress a series of trading orders of the first parties within a given forward term (col. 11, line 5 through col. 12, line 38)(claim 34);

completing a new trading order having a same price term and a same size term as a trading order that was completed between a first party and a second party immediately before the predetermined time period (col. 29, lines 1-42) (claim 36);

automatically adding a new trading order to the trading system having same pricing and size terms as an existing trading order, wherein the new trading order includes information identifying a party at whose user station the addition of the new trading order was entered (col. 11, line 5 through col. 12 line 38) (claim 37).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims are rejected under 35 U.S.C. 103(a) as being unpatentable over the Ausubel patent in view of the Wilton et al. patent (US 6,519,574 B1).

The Ausubel reference discloses a trading system as discussed above except for programming for comparing bid order prices and offer order prices for forwards in a forward term entered at user stations, and generating a spread order representing a difference between compared bid prices and compared offer prices and programming, executable in response to a request entered at a user station, for completing the spread order with the compared bid orders and the compared offer orders included therein.

The Wilton et al. patent teaches comparing bid order prices and offer order prices for forwards in a forward term and generating spread orders representing a difference between compared bid prices and compared offer prices, requesting a completion of a spread order, and completing the spread order, the compared bid orders and the compared offer orders included

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therein (col. 3, lines 55-65 and col. 10, lines 7 through col. 11, line 24) (claims 19 and 35). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Ausubel patent with the teachings of the Wilton et al. patent so as to provide the counterparties with the opportunity to maximize their transactions and customize them to take advantage of various changes in the market.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Mistr patent is for a system of communications between energy suppliers. The Silverman, Sibly, Clearwater, Berent, Fraser, Zandi, Fraser, Nymeyer, Adams, Popolo, Keiser, Johnson (2) patents are all directed to online auction or trading systems. The Gutterman patent is for a system for managing trading commodity orders.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Snapp whose telephone number is 703-305-6940. The examiner can normally be reached on Mon.-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

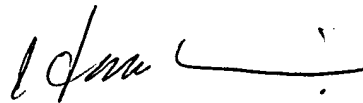
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July 23, 2003



HANI M. KAZIMI
PRIMARY EXAMINER